

Atty. Docket No. JP920000032US1
(590.050)

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded to the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action in light of the following remarks.

Claims 1-7 were pending in the instant application at the time of the outstanding Office Action. Claims 1-7 are independent claims. In the Office Action dated February 4, 2005, Claims 1-7 were rejected. Claims 1, 2, and 3 have been subsequently amended. Applicants intend no change in the scope of the claims by the changes made by this amendment. It should also be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

The Section 112 Rejections

Claims 2 and 3 were rejected under 35 U.S.C. 112 first paragraph for failing to comply with the enablement requirement. Specifically, the Examiner asserts, "Claims 2 and 3 recite the limitation 'transmitting to said user...not only [a] license key but also a program for disabling at least a part of the function of said downloaded.' This limitation is not described in the specification to enable one skilled in the art to make or use the invention." The Applicant respectfully requests reconsideration of the rejection based upon the following indication of specific language contained in the specification that does comply with 35 USC 112 first paragraph.

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Claims 2 and 3 have been rewritten to recite, *inter alia*, “[d]ownloading to said information terminal said license key, said program key, and said selected program file, said program file being capable of referring to said downloaded license key when said downloaded program is activated or executed, and capable of disabling at least a part of the function of said downloaded program, when said program matches a predetermined said licensing condition provided by reference to said license key...”.

The amended language contained in Claims 2 and 3 is fully disclosed in the Specification. Specifically, in the Detailed Description of the Preferred Embodiment it states:

An L-Key (license key) 121, which is referred to when the software 120 is activated or when a specific function of the software 120 is used following activation, and a P-Key, 123, which specifies the software, are embedded in the Software 120. The L-Key includes information concerning usage conditions corresponding to the number of times the software can be used and to the authorized usage period and expiration date. When the software 120 does not match the usage conditions, the use of all or a part of the functions available with the software 120 is inhibited.

(Page 14, lines 3-10) Furthermore, with respect to one embodiment of the present invention it is explained:

[A]n L-Key 121 is generated by using the P-Key 123, the user ID and the current date (step 461). In this embodiment, an L-Key 121 is encrypted so that it can not be freely generated by a user. An L-Key 121 may be designed that a program refers to it to obtain a current date and information for an available included period, or to obtain only a n included current date, and the activation or execution of a program is inhibited after a specific period of time has elapsed following the at date. Further, instead of the current date, information concerning an available period or information concerning the available time for activation (execution) may be included in the L-Key 121.

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(Page 22, lines 11-17) Note, also, that further disclosure can be found, *inter alia*, on Page 3 at line 14 and on Page 25 at lines 9-10.

The selected section of the specification described above clearly provides disclosure of the subject matter contained in the rejected and amended Claims 2 and 3. Moreover, as was indicated in the specification, "Since for one having ordinary skill in the art the technique is well known whereby when a license key is referred to and a condition is matched the execution of the program is halted, and when the condition is not matched the execution of the program is continued, no detailed explanation of this technique [need] be given... ." (Page 24, line 18 - Page 25, line 3) It is respectfully submitted that the technique is, in fact, known to persons skilled in the art; therefore, the disclosure provided in the specification is fully adequate to support the claims. For all of the aforementioned reasons, reconsideration and withdrawal of the rejections under 35 U.S.C. 112 is respectfully requested.

Claims 1-7 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which is the invention. In light of the following remarks the applicant respectfully requests that the rejections be withdrawn.

The Examiner indicates the recitation of "'said preceding step" in Claims 1-3 is unclear due to a "plurality of preceding steps. Claims 1-3 have been amended to recite, *inter alia*, "immediately preceding step" to clearly identify to which step reference is being made. Additionally, the Examiner finds that the "limitation" in Claims 2 and 3,

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which states, “ ‘transmitting ... to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading menu’. [D]oes not clearly show whether the file downloading menu is being transmitted or already has been transmitted based on the limitation ‘introduced into said file downloading [menu].’” As amended the Claims read “[t]ransmitting ... to said information terminal of said user a file downloading service menu or a menu that can be introduced into said **service menu** ...”. (emphasis added) To be clear the “service menu” is introduced in an earlier step and is not the same as the “file downloading service menu.” The file downloading service menu as indicated in the Claims can either be a separate menu or one that is contained within the service menu.

Claims 1, 2, and 3 were also found by the Examiner to be “unnecessarily repetitive” in that each of the Claims repeats limitations set forth earlier in the same claim. However, this is actually not the case. The invention claimed is, *inter alia*, a technique for downloading software and licensing information from a network, which is capable of determining whether the software is authorized for use on the user’s computer. In addition, the technique is also one for updating the licensing information to enable further use of a program already downloaded. Claims 1, 2, and 3 each reflect the invention in two sections. The first section relates to the downloading of the entire software package, i.e., the desired program, a License Key, and a Program Key. Additionally, the claims indicate the subsequent technique for updating the licensing information contained within the L-Key after the software package had already been downloaded. Since, the technique for each shares similarities it may, at first, appear to be

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a repetition of the same steps, within a single claim, when actually they are not.

In order to make this point clearer, but without intending any change in the scope of the claims, or in acquiescence of the Office's position on the allowability of the claims, Claims 1, 2, and 3 have been written. Claim 1 now recites, "[a]gain transmitting, at a time subsequent to said immediately preceding step, a connection request that includes said user ID from said information terminal of said user to said network provider...". Claims 2 and 3 now recite, "[a]ctivating a dialer, at a time subsequent to the termination of said immediately preceding step...". As explained above, the claims are not unduly repetitive, but rather a single claim shares similar steps within itself. Therefore, it is respectfully requested that the rejection be withdrawn.

Finally, under the 35 U.S.C. 112 rejections, the Examiner indicates that Claims 2 and 3 fail to indicate the result of a negative check of the user ID and password during a later connection to the network. Claims 2 and 3 as rewritten indicate the result of a negative yielding response.

The remaining Claims 4 - 7 are believed to particularly indicate and distinctly claim the current invention, therefore, reconsideration and withdrawal of their rejections is respectfully sought at this time.

The Section 103 Rejections

Claims 1-7 also stand rejected under 35 U.S.C. § 103(a) as obvious in light of Ahmad. For the following reasons, reconsideration and withdrawal of the present rejections are, also, hereby respectfully requested.

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As best understood, Ahmad appears to be directed to a method for monitoring the validity of software that is rented to a user from an Internet site. (Col. 2, lines 11-19)

The method seems to be accomplished through a process whereby a user downloads three (3) modules: a Check-in/Check-out (CICO) module; a Software Monitor (SM) module; and a program module. The CICO appears to supply relevant licensing information to the program module via the SM. The SM in turn, appears, to enable or disable the program according to the current licensee, as well as tracking the use of the program when the licensed information is found to allow for the program modules use. A user desiring to rent some particular software module will first access an Internet location where the appropriate contract and payment can be made, afterwards, the modules are downloaded. After the allotted rental time has expired the user can "[r]e-rent the program module for subsequent use. For subsequent rental of the program module by the user, there is no need to download the program module from the rental service provider's server, but a new CICO module must be downloaded from the real service provider's server for such subsequent rentals of the program module." (Col. 14, lines 67 - Col. 15, lines 5) The Ahmad invention focuses upon overcoming the problem of monitoring rented software. (Col. 15, lines 6-8)

Broadly, the instantly claimed invention provides a method and system for the distribution of free software by an Internet provider to and for the use of its customers during the time in which the user remains a customer of the Internet provider. However, should the user end its relationship with the Internet provider, the present invention also provides a method for ensuring that the continued use of the software by the user is no

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longer possible; furthermore, the presently claimed invention, also, provides a way in which the licensing information required for use of the provided software can be updated upon the connection of the user to the Internet Service Provider.

A fundamental difference between the way in which the current invention and that of Ahmad achieve their respectively different ends is the present invention's use of a P-Key (or Program Key). The Ahmad invention neither claims, teaches, suggests, nor provides a motivation for a P-Key; therefore, there can be no proper rejection of the instantly claimed invention as being obvious in view of Ahmad. To fully appreciate this conclusion it will be helpful to describe in more detail the current invention and its use of the P-Key.

In general terms, after a user has entered into a contractual agreement with the Internet provider for access to the Internet, the user will be given a user ID and password to access Internet via the provider. Upon connecting with the Internet provider the user enters the ID and password, which when authenticated provides verification that access is to be had. The present invention provides the user with a service menu and, importantly, checks to see if there are any programs provided by the Internet provider already housed on the user's computer. This is accomplished through the use of the P-Key, which identifies information relating to the programs provided by Internet provider. If for example, it is the user's first time connecting to the Internet via the provider no programs and, thus, no P-Keys will be found. Instead, the user will be provided with a download service menu that will allow the user to select a particular program for download and use on the user's computer. In such a situation, the invention allows for a unique L-Key to be

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created related to the P-Key associated with the program to be downloaded from the provider and the user's particular ID, which is accessed via an IP address that is provided to the user upon connection and verification with the provider. The user will then receive the desired program, an L-Key, and an P-Key. Upon activation of the program, the program will determine whether use of the program should be enabled or disabled as indicated by the L-Key, which in turn was generated upon the user's authorized accessing of the Internet via the provider. Unlike Ahmad, the licensing information contained on the L-Key is directly tied to the user's fulfillment of the conditions required for access to the Internet via the provider. Thereby solving the enclosure need. Ahmad's licensing information is merely related to a prior agreement to rent software. More importantly, Ahmad does not provide any type of P-Key with its downloaded program.

Whether Ahmad can be viewed as downloading material similar to the present invention is immaterial, because it is clear that Ahmad does not provide a P-Key with its download. As mentioned above, in the present invention a user upon his first download of a program will be give an L-Key, a P-Key, and the desired program. However, after receiving these items the user can continue to use the desired program, simply, through updating the L-Key. The updating in this method is done with the use of the P-Key. If when checked, as described above, a user is found to have P-Keys stored on the user's computer, the user will not be provided with a menu to select program downloads, but rather will be given an updated L-Key to enable the continued use of the desired program already having been downloaded. By way of providing an overview of the process, the present invention sends to the Internet provider its P-Key, which is then used, in a manner

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similar to that described before, i.e., in combination with the user's ID, to generate the appropriate L-Key. Again, the L-Key is only created because the user was found to have properly accessed the Internet provider's site.

In comparison, Ahmad provides no P-Key, because one is not required. Ahmad, appears to suggest that its invention can be updated via the Internet by simply entering into another contractual relationship with the program provider who will then provide the CICO module. Once the CICO module is downloaded the program module can once again be used and monitored. This means that Ahmad does not provide the requisite motivation to modify the reference as required to find obviousness, since there is absolutely no for the Ahmad invention to have a P-Key. Arguably, therefore, Ahmad teaches away from the present invention for this reason as well.

As the Examiner is aware, to establish a *prima facie* case of obviousness under 35 U.S.C. 103 there must be: a suggestion or motivation to modify the reference; a reasonable expectation of success of the modification; and the prior art reference must teach or suggest all the claim limitations. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Again as was stated at the outset of this discussion, because the Ahmad invention clearly does not claim, teach, suggest, or provide a motivation for a P-Key as is used in the present invention there can be no proper rejection of the invention as being obvious in view of Ahmad.

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Conclusion

In view of the foregoing, it is respectfully submitted that Claims 1-7 are definite and particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Furthermore, Claims 1-7 are fully supported by disclosure of the application and provide the enablement for one skilled in the art to make and/or use the invention. Finally, it is also submitted that Claims 1-7 are fully distinguishable over the applied art and in no way obvious in view thereof and, thus, they are allowable.

The "prior art made of record" has been reviewed. Applicant acknowledges that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicant will be fully prepared to respond thereto.

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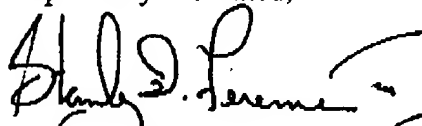
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In summary, it is respectfully submitted that the instant application, including Claims 1-7, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

Customer No. 35195
FERENCE & ASSOCIATES
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicant